

## **RESPONSE TO OFFICE ACTION**

### **A. Status of the Claims**

Claims 1-26 were filed and are presented for reconsideration.

### **B. Objection to the Specification**

The specification is objected to for including blank lines. In response, Applicants note that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules and that the specification will be amended to include the corresponding accession number and date of deposit in place of the blank lines.

### **C. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph**

The Action rejects the claims under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out the subject matter which Applicants regard as the invention. The individual rejections and Applicants' responses thereto are set forth below.

(1) The Action objects to claims 3 and 4 as not further limiting the claims from which they depend. Applicants traverse as the claims are further limiting. For example, claim 3 requires that the population of seed of claim 2 further be "an essentially homogeneous population of seed." Claim 4 further requires that the population of seed of claim 2 be "essentially free from hybrid seed." Nothing in claim 2 requires these elements. Rather the population merely needs to be "[a] population of the seed..." Nothing would require a population of seed according to claim 1 to be absolutely homogenous or completely free of some contaminating hybrid seed. For example, the

relevant definition of “population” from the on-line version of the Merriam-Webster™ dictionary is “a body of persons or individuals having a quality or characteristic in common.” In contrast, the definition for “homogeneous” from the same on-line dictionary is given as “of uniform structure or composition throughout.” Therefore a collection of seed may at one time have a quality or characteristic in common, *e.g.*, be of a given variety, yet not be of uniform structure or composition throughout. A population can also contain contaminants. This is no different than claiming compositions comprising different specified purities of active ingredient. Claims 3 and 4 are therefore in proper dependent form and not indefinite. Withdrawal of the objection is thus respectfully requested.

(2) The Action asserted that in claim 14 “capable of” is indefinite because it is unclear whether the plant does or does not express the physiological or morphological traits of the claimed variety. Applicants traverse as the term has a clear meaning in the art and claim breadth is not indefiniteness. One of skill in the art would understand whether a corn plant is capable of expressing all of the traits of the claimed corn plant because Appellants have provided the corn plant by way of a proffered biological deposit with the ATCC and have described the characteristics of this plant. One of skill in the art would therefore readily ascertain whether a plant is capable of expressing all of the traits of the claimed variety based on direct comparisons under similar growing conditions. Because this standard is readily ascertainable, the use of the limitation in the claims is not indefinite.

Applicants also note that the same issue has been favorably decided by the Board of Patent Appeals and Interferences. Specifically, on March 31, 2005 the Board of Patent

Appeals decided six substantially similar appeals brought by the assignee or a wholly owned subsidiary thereof: Appeal Nos: 2004-1503 (Ser No. 09/606,808), 2004-1506 (Ser. No. 09/788,334), 2004-1968 (Ser. No. 10/000,311), 2004-2317 (Ser. No. 09/771,938), 2004-2343 (Ser. No. 09/772,520); and 2005-0396 (Ser. No. 10/077,589) (collectively “the corn variety appeals”). The claims at issue in these cases were substantially identical in scope to those of the current case.

The same rejection was made and reversed, for example, in Appeal No. 2005-0396. In that case claim 20 read as follows “20. A corn plant regenerated from the tissue culture of claim 17, wherein the corn plant is capable of expressing all of the physiological and morphological characteristics of the corn variety designated I180580, wherein a sample of the seed of the corn variety I180580 was deposited under ATCC Accession No. PTA-3224.” The Examiner rejected the claim on the same grounds as here, namely that because the claims use the term “capable” the claims do “not make clear if the plant actually expresses the traits, or when or under what conditions the traits are expressed.” The Board reversed, explaining that

To address the examiner’s concerns, we find it sufficient to state that if a plant has the capacity to express the claimed characteristics it meets the requirement of the claim regarding ‘capable of,’ notwithstanding that due to a particular phase of the life cycle the plant is not currently expressing a particular characteristic. Alternatively, if a plant is incapable of expressing the claimed characteristics at any phase of the life cycle, because it lacks, for example, the ‘transcription factor’ required for expression - such a plant would not meet the requirement of the claim regarding “capable of.”

Here, we find the examiner’s extremely technical criticism to be a departure from the legally correct standard of considering the claimed invention from the perspective of one possessing ordinary skill in the art. In our opinion, a person of ordinary skill in the art would understand what is

claimed. *Amgen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991). We find the same to be true for the phrase ‘capable of’ as set forth in claims 17 and 20.

Decision at p. 12.

In view of the foregoing, withdrawal of the rejection is respectfully requested.

(3) Claim 20 is rejected for not reciting three or more generations of crossing.

Applicants respectfully traverse, but note that the claim has been amended herein. The rejection is therefore believed moot and removal thereof is this respectfully requested.

(4) Claim 21 is rejected as unclear regarding “a corn genome.” In response it is noted that the claim has been amended herein and that the rejection is believed moot. Removal of the rejection is thus respectfully requested.

(5) In claims 23 it is stated that “yield enhancement,” “improved nutritional quality” and enhanced yield stability” are relative and thus indefinite. In response it is noted that the terms have been deleted and thus the rejection is moot.

#### **D. Rejection of Claims Under 35 U.S.C. §112, First Paragraph - Enablement**

(1) The Action rejects claims 1-26 under 35 U.S.C. §112, first paragraph, for lack of a seed deposit. In response, Applicants note that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules. A declaration certifying that the deposit meets the criteria set forth in 37 C.F.R. §1.801-1.809 will be provided and the claims amended to recite the corresponding accession number. The specification will also be amended to include the accession number of the deposit and the date of deposit.

(2) The Action rejects claim 23 as not enabled for “yield enhancement,” “improved nutritional quality” or “enhanced yield stability” because they are conferred by multiple loci. In response, Applicants note that the terms have been deleted herein and thus the rejection is moot.

**D. Rejection of Claims Under 35 U.S.C. §112, First Paragraph – Written Description**

The Action rejects claims 23 as lacking written description for “yield enhancement,” “improved nutritional quality” or “enhanced yield stability” because they are conferred by multiple loci. In response, Applicants note that the terms have been deleted herein and thus the rejection is moot.

**E. Rejection of Claims Under 35 U.S.C. §102(b)**

(1) The Action rejects claims 14 and 24 on the basis that claim 14 reads on plants “capable of” expressing the traits of the exemplified inbred and claim 24 on plants produced by crossing, and that the claims could allegedly read on cited plants said to have some of the traits of the exemplified corn variety.

Applicants respectfully traverse as no showing that the cited references actually do teach the claim limitations or for concluding that such properties are inherent has been made. No basis for shifting the burden on the Applicants has therefore been shown because the claims fully distinguish over the prior art. For example, a review of the morphological descriptions of the cited varieties relative to the current description reveals that the cited and current varieties differ in numerous traits, including many non-quantitative traits with minimal environmental influence, if any. There is simply no basis

to conclude that the cited plants could be capable of expressing the traits of the exemplified variety under any environmental conditions. There is therefore no basis to conclude the claims read on the prior art or to shift the burden to Applicants.

Hypothetical possibilities do not suffice to support a prior art rejection. The claimed subject matter has been fully defined over the art. In contrast, the Action appears to be alleging that the cited plants *may* be the same as the claimed subject matter. However, other than the recitation of a few selected traits, the Action made no attempt to show that the cited varieties anticipate the subject matter of the claims. Under 35 U.S.C. § 102 it is the burden of the Office to show that *each and every* element as set forth in the claim is found in the prior art. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). This has not been done and the anticipation rejection must therefore fail.

To the extent that unexpressed inherent characteristics of the cited variety form the basis of the anticipation rejection, it is noted by Applicants that these characteristics must necessarily flow from the prior art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) ("To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."). Here, it is merely stated that the cited varieties share *some* of the same characteristics and there is

no showing that any other traits *are* necessarily present. The Action has thus failed to meet the burden under 35 U.S.C. §102 or §103.

Finally, Applicants note that a rejection must be supported by “substantial evidence” in accordance with the Administrative Procedure Act (“APA”). 5 U.S.C. § 706(A), (E), 1994; *see also In re Zurko*, 59 USPQ 2d 1693 (Fed. Cir. 2001). The current rejection is not properly supported because it is based on hypothetical possibilities. The burden has further not been shifted to Applicants because the claims define over the prior art as set forth above. No basis for the rejection has therefore been provided or exists. Withdrawal of the rejection is thus respectfully requested.

(2) The Action also rejects the claims as anticipated under 35 U.S.C. §102(b) on the basis of the information provided in the response to the 37 C.F.R. §1.105 Request. In particular, it was indicated that varieties 89DUD3 and 91DUD4 were known in the art and, absent evidence to the contrary, are the same as and anticipate the currently claimed variety. In response, Applicants have attached herewith the Declaration of Timothy R. Kain showing the results of an objective description taken of varieties 89DUD3 and 91DUD4. As explained by Mr. Kain, the results demonstrate that varieties 89DUD3 and 91DUD4 do not teach or suggest corn variety I900420. The rejection is therefore believed moot.

In view of the foregoing, removal of the rejection is respectfully requested.

**F. Conclusion**

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicants submit that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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